



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/725,206	04/19/85	JEFFERY J	BOOTS12CONT.I

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EXAMINER	
OSHAWER, F	
ART UNIT	PAPER NUMBER
124	8
DATE MAILED 1/22/86	

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1024, 42 to 49, and 52 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 25 to 41, 50, and 51 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1024, 42 to 49, and 52 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Art Unit 142

Claims 1 to 24, 42 to 49, and 52 are directed to the same invention as that of claims 1 to 29 of commonly assigned U.S. Patent No. 4,443,449. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see M.P.E.P. 1101.01(b)), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) and (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of the application.

Claims 1 to 24, 42 to 49, and 52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 to 29 of prior U.S. Patent No. 4,443,449.

This is a double patenting rejection.

Claims 1 to 24, 42 to 49 and 52 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claims 1, 3 to 7, 9 to 13, 15 to 24, 42, 50, and 51 of U.S. patent no. 725,129 in view of 4,443,449.

Serial No. 725,206

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Art Unit 142

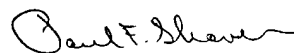
4,443,449 teaches the equivalence of 1-6C alkyls with respect to R₁.

Applicants' attention is directed to claims 30 to 32 of 4,443,449 and claims 1 to 29 of 4,522,828.

Shaver/kl

703/557-3920

12-21-85



PAUL F. SHAVER
PRIMARY PATENT EXAMINER
GROUP ART UNIT 124